

### REMARKS

Claims 1 and 13 have been amended to include the limitation that the lotion is applied to the topsheet "in a pattern comprising a plurality of elements, each having a predetermined size" and to delete a previously added limitation, which Applicants believe was not furthering prosecution. Antecedent basis for the added limitation can be found on page 26, lines 32-35 and page 27, lines 21-27. No new matter has been added by these amendments. Entry is believed to be proper and respectfully requested.

#### 35 USC 103 over Duncan

The Examiner rejected Claims 1, 4-7, 9-11, 13 and 16-20 under 35 U.S.C. 103 as being unpatentable over Duncan et al. (USPN 3,489,148) The Examiner suggested that Duncan discloses that the topsheet has multiple discrete droplets of a lotion composition which form a pattern. The Examiner acknowledged that Duncan is mainly concerned with a hydrophobic topsheet. However, the Examiner suggested that it is well known to use lotion on a hydrophilic topsheet. The Examiner further stated that the immobilizing agents of claims 12, 13, 21 and 22 are disclosed by Duncan as the viscosity additives.

Applicants respectfully traverse.

As the Examiner has acknowledged, Duncan merely teaches applying droplets of lotion on a hydrophobic-oleophobic topsheet. Duncan specifically states that this approach is not effective if the diaper does not have a hydrophobic topsheet (Duncan, col. 2, lines 7-9). Clearly, Duncan teaches away from using a hydrophilic topsheet. A person of ordinary skill in the art would not be motivated by Duncan to put lotion on a hydrophilic topsheet as claimed by the present invention. The Examiner has not provided any rationale why a skilled artisan would choose to ignore the specific teaching away by Duncan.

The Examiner has stated generally that "it is well known to use lotion on a hydrophilic topsheet" but has not provided any reference to support this basis of rejection. Applicants respectfully point out that the Federal Circuit has held that "basic knowledge" or "common sense" not based on any evidence in the record lacks substantive evidence support. *In re Zurko*, \_\_ U.S.P.Q.2d \_\_ (Fed. Cir. Aug. 21, 2001). Moreover, the CCPA had stated that "Equally important is the question of what role the facts so found may play in the evidentiary scheme upon which a rejection of claims is based. Typically, it is found necessary to take notice of facts, which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular ground for rejection. The facts so noticed serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. We know of no case in which facts judicially noticed . . . were of such importance as to constitute a new ground of rejection when

combined with the other evidence previously used.” *In re Ahlert*, 424 F.2d. 1088; 165 U.S.P.Q. 418 (CCPA 1970). Here, the Examiner is relying on the “basic knowledge” of one of ordinary skill in the art to contradict the teaching of the cited reference and to bridge the gap in the evidentiary showing required to support a ground for rejection. Clearly, the Examiner has failed his burden of proof. For this reason alone, the rejection should be withdrawn.

Further, Duncan teaches applying a barrier material on an oleophobic-hydrophobic topsheet to form “discrete droplets” of uncontrolled sizes. Specifically, the discrete droplets have diameters ranging from about 0.05 mm to about 1.0 mm (Duncan, col. 3, lines 47-50). Applicants submit that the teachings of Duncan would not result in the presently claimed articles wherein the lotion is applied to a hydrophilic topsheet “in a pattern having a plurality of elements, each having a predetermined size”.

Therefore, Applicants respectfully request withdrawal of this basis of rejection.

With respect to the rejections of claims 12, 13, 21 and 22, Duncan’s viscosity additives include triglycerides of fatty acids, inorganic materials and metal salts of C12-C22 fatty acids. Specifically, triglycerides of higher fatty acids and metal salts of fatty acids contain, respectively, glycerol moieties and metal ions, neither of which are present in the claimed immobilizing agents. These additives are distinct materials from the claimed immobilizing agents. Thus, a *prima facie case* of obviousness has not been met (*see* MPEP 706.02(j) which requires that the prior art references teach or suggest all of the claim limitations).

Therefore, Applicants respectfully request withdrawal of this basis of rejection.

#### 35 USC 103 over Duncan in view of Buchalter

The Examiner rejected Claims 1, 4-7, 9-13, and 16-26 as being obvious over Duncan in view of Buchalter. The Examiner suggested that Duncan discloses that the topsheet has multiple discrete droplets of a lotion composition which form a pattern. The Examiner stated that Duncan does not disclose the use of the specific lotions claimed. The Examiner cited Buchalter as disclosing an oil phase impregnant alleging that the oil phase is similar to the specific lotion compositions claimed by Applicants in the present application. The Examiner stated that it would have been obvious to one of ordinary skill in the art to use the skin care composition of Buchalter on the diaper of Duncan.

Applicants respectfully traverse.

Applicants submit that combining the teachings of Duncan with those of Buchalter would not result in the claimed articles wherein the lotion is applied to a hydrophilic topsheet “in a pattern having a plurality of elements, each having a predetermined size”. Applicants submit that neither reference teaches nor suggests the above-mentioned claim limitations. Thus, a *prima facie case* of

obviousness has not been met (*see* MPEP 706.02(j) which requires that the prior art references teach or suggest all of the claim limitations).

Therefore, Applicants respectfully request the Examiner withdraw the present 103 rejection.

CONCLUSION

The above is a complete response to the Office Action, dated June 19, 2001. Reconsideration of this application in view of the accompanying remarks and amendments, and allowance of the claims are respectfully requested.

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Respectfully submitted,  
FOR: Roe et al.

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Claims 1 and 13 have been amended as follows:

1. (5 Times Amended) A disposable article comprising:

A) a liquid impervious backsheet;

D) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin; and

E) an absorbent core positioned between said topsheet and said backsheet;

wherein the lotion is applied to the liquid pervious topsheet in a [predetermined] pattern having a plurality of elements, each having a predetermined size such that macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.

13. (5 Times Amended) A disposable article comprising:

A) a liquid impervious backsheet;

B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

(iii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C; and

7.

D) an absorbent core positioned between said topsheet and said backsheet;  
wherein the lotion is applied to the liquid pervious topsheet in a [predetermined] pattern  
having a plurality of elements, each having a predetermined size such that macroscopic  
regions of the topsheet are untreated and the topsheet has a percent open area of from about  
5% to about 99%.